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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,656	01/29/2004	Neil Hepburn	2003-IP-010320 U1 USA	5392
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KONNEKER & SMITH P. C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			EXAMINER COY, NICOLE A	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/767,656	Applicant(s) HEPBURN ET AL.	
	Examiner Nicole Coy	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection. Claims 1-47 are rejected over newly found reference Smith et al. (USP 6,883,611).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 11, 14-17, 19-21, 23, 25-33, 37, 38, 41-44, 46, and 47 are rejected under 35 U.S.C. 102(e) as being anticipated by Smith et al. (USP 6,883,611).

With respect to claim 1, Smith et al. discloses a method of completing a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the method comprising the steps of: positioning an assembly in the window (42); and swelling a sealing material (70) on the assembly (see column 5 lines 58-67), so that a first seal is formed between the assembly (42; wherein the seal is formed with 44 and the window, and 44 is part of 42) and the window (62).

With respect to claim 2, Smith et al. discloses that the swelling step further comprises increasing a volume of the sealing material (see column 5 lines 58-67).

With respect to claim 3, Smith et al. discloses that the positioning step further comprises positioning the assembly (42) at least partially in the parent wellbore and at least partially in the branch wellbore (see figure 3, wherein 44, which is part of assembly 42) is positioned in the parent wellbore and 42 is in the branch wellbore).

With respect to claim 4, Smith et al. discloses that the assembly is a tubular string (42), and wherein the positioning step further comprises deflecting the tubular string from the parent wellbore into the branch wellbore (see figure 3 wherein 42 is deflected off of whipstock 30).

With respect to claim 5, Smith et al. discloses the step of providing fluid communication between an interior of the tubular string (42) and the parent wellbore (12) via an opening formed through a sidewall of the tubular string (see figure 3).

With respect to claim 6, Smith et al. discloses that the swelling step further comprises forming a second seal between the tubular string and the parent wellbore (wherein seal 70 is formed above and below the window; see figure 7).

With respect to claim 7, Smith et al. discloses that the swelling step further comprises forming the first and second seals (70) on opposite sides of the opening (see figure 3).

With respect to claim 11, Smith et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the system comprising: a tubular string (42) having a portion positioned within

the window (see figure 3); and a sealing material (70) on the tubular string portion (see figure 3 and column 5 lines 58-67), the sealing material swelling in the well to thereby form a first seal (70) between the tubular string portion and the window (see figure 3 and column 5 lines 58-67).

With respect to claim 14, Smith et al. discloses that a volume of the sealing material increases as the sealing material swells (see column 5 lines 58-67).

With respect to claim 15, Smith et al. discloses that the tubular string portion (44) extends within the parent wellbore (12), the sealing material (70) forming a second seal between the tubular string portion and the parent wellbore (see figure 3).

With respect to claim 16, Smith et al. discloses that tubular string portion has an opening formed through a sidewall thereof (see figure 3), the opening providing fluid communication between an interior of the tubular string and the parent wellbore (see figure 3).

With respect to claim 17, Smith et al. discloses that the opening is positioned between the first seal and a second seal (70) formed by the sealing material between the tubular string portion and the parent wellbore (see figure 3).

With respect claim 19, Smith et al. discloses that the tubular string (42) extends into the branch wellbore (40) below the window (62), and wherein the tubular string (42) extends in the parent wellbore above the window (see figure 3).

With respect to claim 20, Smith et al. discloses that the sealing material (70) is a coating applied externally to the tubular string portion (see column 5 lines 58-67).

With respect to claim 21, Smith et al. discloses a method of completing a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the method comprising the steps of: positioning an assembly (42, which includes 44) in the parent wellbore (12; see figure 3, wherein 44 is in the parent wellbore); forming an opening through a sidewall of the assembly (62); aligning the assembly with the window (see figure 3); and swelling a sealing material on the assembly, so that a first seal is formed about the opening (see column 5 lines 58-67).

With respect to claim 23, Smith et al. discloses that the forming step is performed before the positioning step (see column 3 lines 26-32).

With respect to claim 25, Smith et al. discloses that the forming step is performed before the swelling step (see figure 3).

With respect to claim 26, Smith et al. discloses that the aligning step further comprises aligning the opening with the window (see figure 3, wherein the opening is aligned with the window).

With respect to claim 27, Smith et al. discloses that the swelling step further comprises forming the first seal (70) between the assembly (42) and the parent wellbore (12) circumferentially about the window (see figure 3).

With respect to claim 28, Smith et al. discloses that the swelling step further comprises forming the first seal (70) between the assembly (42) and circumferentially about an end (see figure 3) of a tubular string (42) positioned in the branch wellbore (40).

With respect to claim 29, Smith et al. discloses that the swelling step further comprises increasing a volume of the sealing material (see column 5 lines 58-67).

With respect to claim 30, Smith et al. discloses the step of externally securing the sealing material (70) on a tubular structure (64), and wherein the swelling step further comprises forming the first seal to provide a sealed flowpath between the branch wellbore and an interior of the tubular structure (see figure 3).

With respect to claim 31, Smith et al. discloses that the swelling step further comprises forming a second seal (70) between the tubular structure and the parent wellbore (12; see figure 3).

With respect to claim 32, Smith et al. discloses that the second seal forming step further comprises forming the second seal above the window (see figure 3, wherein there is seal 70 above and below the window).

With respect to claim 33, Smith et al. discloses that the second seal (70) forming step further comprises forming the second seal below the window (see figure 3, wherein there is seal 70 above and below the window).

With respect to claim 37, Smith et al. discloses that the aligning step further comprises engaging a latch of the assembly (42) with an orienting latch profile (20).

With respect to claim 38, Smith et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the system comprising: an assembly positioned in the parent wellbore (42, which includes 44), the assembly having an opening (62) formed through a sidewall thereof (see figure 3), the opening (62) being aligned with the window (see figure 3);

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and a sealing material (70) on the assembly (42), the sealing material swelling in the well to thereby form a first seal circumferentially about the opening (see column 5 lines 58-67).

With respect to claim 41, Smith et al. discloses that a volume of the sealing material increases as the sealing material swells (see column 5 lines 58-67).

With respect to claim 42, Smith et al. discloses that the sealing material forms a second seal between the assembly and the parent wellbore (see figure 3, wherein there is a seal 70 above and below the window).

With respect to claim 43, Smith et al. discloses that the first seal (70) is formed between the assembly (42) and the parent wellbore (12) circumferentially about the window (see figure 3).

With respect to claim 44, Smith et al. discloses that the first seal (70) is formed between the assembly (42) and an end of a tubular string (44) positioned in the branch wellbore (40).

With respect to claim 46, Smith et al. discloses that the assembly (42) includes a tubular structure (see figure 3), and wherein the first seal (70) provides a sealed flowpath between the branch wellbore (40) and an interior of the tubular structure (see figure 3).

With respect to claim 47, Smith et al. discloses that the sealing material (70) is a coating applied externally to the tubular structure (see column 5 lines 58-67).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al.

With respect to claim 22, Smith et al. does not disclose that the forming step is performed after the positioning step. However, determining the order of steps in a method of forming a branch borehole and positioning a tubular string in it requires only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to modify Smith et al. so that the forming step is performed after the positioning step.

With respect to claim 24, Smith et al. does not disclose that the forming step is performed after the swelling step. However, determining the order of steps in a method of forming a branch borehole and positioning a tubular string in it requires only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to modify Smith et al. so that the forming step is performed after the swelling step.

6. Claims 8-11, 13, 18, 34-36, 39, 40, 45, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. in view of Thomson (US 2004/0194971).

With respect to claims 8, 18, 34, and 45, Smith et al. is silent as to the type of expanding and/or elastomer sealing material. Thomson discloses coating a conduit with rubber material which expands in order to help prevent movement of the expandable member that may be caused by, for example, expansion or contraction of the member or other tubular members within the borehole and/or accidental impacts or shocks (see page 1 paragraph [0002]). It would have been obvious to modify Smith et al. by including a rubber seal which expands as taught by Thompson in order to help prevent movement of the assembly the coating is on and accidental impacts or shocks.

With respect to claims 9, 11, 35, and 39, Smith et al. in view of Thomson teaches that the swelling step further comprises swelling the sealing material in response to exposing the sealing material to hydrocarbon fluid in the well (see Thomson page 1 paragraph [0008]).

With respect to claims 10, 13, 36, and 40, Smith et al. in view of Thomson teaches that the swelling step further comprises swelling the sealing material in response to exposing the sealing material to water in the well (see Thomson page 1 paragraph [0008]).

Conclusion

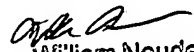
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 8:00-5:30, 1st F off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

nac


William Neuder
Primary Examiner